

TTAB



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File Number: 83081-00074

Document Number: 1489103.1

August 4, 2005



08-09-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: ***Petition to Cancel***

Petitioner: Brasserie De Tahiti, S.A,
Mark: TAHITI
Registration No.: 2,637,736 / 76 313 393
Class: 32
Date Registered: October 15, 2002
Our Ref. No.: 83081-00074

Dear Sir/Madam:

Enclosed herein is a Petition to Cancel in connection with the above-referenced trademark.

Please charge \$300 for the filing fee of the Petition to Cancel to our Deposit Account No. 50-1833. A duplicate copy of this letter is enclosed for this purpose.

Please direct all communications regarding this matter to the undersigned.

Very truly yours,

Benita M. Das

BMD:mlc

Enclosures:

- (1) Petition to Cancel
- (2) Exhibit A, B, C, D
- (3) Authorization to Charge Deposit Account
- (4) Postcard
- (5) Certificates of Mailing

CERTIFICATE OF MAILING

I, Maria Caunan, hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on August 4, 2005.

Maria Caunan

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark Registration No.
2,637,736
For the mark: TAHITI
Date Registered: October 15, 2002

Brasserie De Tahiti S.A.,

Petitioner,

v.

Daniel Marshall,

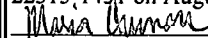
Registrant.

Cancellation No. _____

Petition To Cancel

CERTIFICATE OF MAILING

I, Maria Caunan, hereby certify that the attached documents are being deposited with the United States Postal Service as addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on August 4, 2005.



Maria Caunan

PETITION TO CANCEL

I. The Parties

1. Petitioner, Brasserie De Tahiti S.A., a French Polynesian corporation, having a place of business at 17 Place Notre Dame, BP 597 Papeete, Tahiti 98713 ("Petitioner") believes that it will be damaged by the continued registration of TAHITI as reflected in United States Registration No. 2,637,736 ("Disputed Mark") and hereby petitions to cancel the same.

2. On information and belief, Daniel Marshall, 270 N. Canon Drive #1239, Beverly Hills, CA 90210 ("Registrant") is the current owner of the Disputed Mark.

08/12/2005 6THOMAS2 00000004 501833 2637736

01 FC:6401 300.00 DA

II. Marks at Issue

A. Petitioner's Mark

3. Petitioner is the owner of the mark O'TAHITI ("Petitioner's Mark"). Through its efforts and expenditures in connection with advertising, promotional and marketing services, Petitioner has developed valuable goodwill and consumer recognition in its O'TAHITI mark for bottled water.

4. Petitioner has filed U.S. Trademark Application Serial No. 76/604,251 for Petitioner's Mark for "bottled water" in International Class 32. A printout from the U.S. Patent and Trademark Office Trademark Application and Retrieval System ("TARR") database regarding Application Serial No. 76/604,251 is contained in Exhibit A. The attached Exhibit A is incorporated herein by reference.

5. Petitioner uses Petitioner's Mark in the United States in connection with the distribution and retail sale of bottled water imported from Tahiti.

6. Petitioner is a major importer of a broad array of goods from Tahiti, including but not limited to, alcoholic and non-alcoholic beverages, bags, clothing, leather goods and paper products, all of which are sold and distributed in several countries including the U.S.

B. Disputed Mark

7. On September 18, 2001, Registrant filed an application for the Disputed Mark TAHITI for "bottled drinking water" in International Class 32, and on June 4, 2002 Registrant filed an Amendment to Allege Use claiming a date of first use in commerce of March 13, 2002.

8. Registrant obtained registration of the Disputed Mark, Registration No. 2,637,736, on the Supplemental Register on October 15, 2002. A printout from the TARR

database regarding Registration No. 2,637,736 is contained in Exhibit B. The attached Exhibit B is incorporated herein by reference.

As grounds for cancellation, Petitioner alleges as follows:

C. The Disputed Mark is Primarily Geographically Deceptively Misdescriptive.

9. On information and belief, the Disputed Mark is primarily geographically deceptively misdescriptive of the listed goods in violation of 15 U.S.C. 1052 (e)(3). The primary significance of the Disputed Mark is geographic. TMEP §1210.03. Because the Disputed Mark consists of a single term that is a widely recognized geographic location, consumers of bottled water products bearing the Disputed Mark are highly likely to believe that the goods originate in Tahiti. Because Registrant's goods do not originate in Tahiti and have no connection to Tahiti whatsoever, Registrant is in violation of 15 U.S.C. 1052(c)(3). TMEP §1210.01.

10. On information and belief, the Tahitian government requires exporters to receive authorization from the Customs Department of French Polynesia before exporting goods from Tahiti. Moreover, on information and belief, Registrant is not authorized by the Tahitian government to export to the U.S. water originating from Tahiti. Thus, Registrant has no potential to correct the deception that Registrant's bottled water sold under the TAHITI mark comes from Tahiti.

10.1 On information and belief, attached as Exhibit C is a true and correct copy of an October 28, 2004 official English translation of an original letter in French dated October 18, 2004 from Emile Vanfasse, Minister of the Ministry of the Economy and Finance of French Polynesia confirming that Registrant is not on the Customs Department of French Polynesia list of exporters of water to the U.S. Exhibit C is attached hereto and incorporated by reference herein.

10.2 On information and belief, attached as Exhibit D is a true and correct copy of a May 3, 2005 official English translation of an original letter in French dated April 26, 2005 from Joel Quiniou, Regional Manager, Customs Department of French Polynesia verifying that Registrant is not listed as an authorized exporter of water to the U.S. Exhibit D is attached hereto and incorporated by reference herein.

11. Based on the information provided by the Government of French Polynesia, Registrant is not listed as an exporter of water from Tahiti to the U.S.

D. Invalid First Use Date

12. During the prosecution of the underlying application for Registration No. 2,637,736, Registrant claims a first use date in commerce of March 13, 2002.

13. On information and belief, the goods listed in the registration for Disputed Mark are not and were not at the time of the filing of the Amendment to Allege Use for the Disputed Mark sold in interstate commerce as alleged in the underlying application. As such, the Registrant did not qualify the Disputed Mark for Federal registration and supplied inaccurate and/or fraudulent information to the USPTO in order to obtain Federal trademark registration. As such, the Registration No. 2,637,736 for the Disputed Mark is invalid.

E. Abandonment of Registration

14. On information and belief, Registrant has not made use of the Disputed Mark in interstate commerce in connection with the goods identified in Registration No. 2,637,736 for three (3) consecutive years. Thus, Registrant has statutorily abandoned the Disputed Mark by intentionally not using it in interstate commerce for three consecutive years. 15 U.S.C. §1127.

F. Likelihood of Confusion

15. Petitioner will be damaged by the continued registration of the Disputed Mark. Specifically, a United States Patent and Trademark Office Examining Attorney is of the opinion that Petitioner's Mark consists of or comprises a mark which so resembles the Disputed Mark set forth in Registration No. 2,637,736 as to be likely to cause confusion, or to cause mistake, or to deceive, under 15 U.S.C. 1052(d).

16. If the Registrant is permitted to retain the registration sought to be cancelled, and thereby, the prima facie exclusive right to use Disputed Mark in commerce on the identical goods sold by Petitioner, consumer confusion is likely to result from concurrent use of Petitioner's Mark and Disputed Mark all to the great detriment of Petitioner, who has expended considerable sums and effort in promoting its mark.

17. Purchasers are likely to consider the goods of the Registrant if sold under Disputed Mark as emanating from Petitioner, and purchase such goods as those of the Petitioner, resulting in loss of sales to Petitioner.

18. Concurrent use of the mark by the Registrant and Petitioner would result in irreparable damage to Petitioner's reputation and goodwill, if the goods sold by the Registrant are inferior or inauthentic, since purchasers are likely to attribute the source of the Registrant's goods to the Petitioner.

19. If Registrant is permitted to retain the registration sought to be cancelled, a cloud will be placed on Petitioner's title in and to Petitioner's Mark and on its right to enjoy the exclusive use thereof in connection with the sale of its goods, or to take full advantage of licensing opportunities for its highly-recognized mark, all to the detriment of Petitioner.

20. If Registrant is permitted to continue to maintain its invalid and deceptive registration, the same would be deemed incontestable after five (5) years from the date of registration, and Registrant would thereby obtain an incontestable right to the use of its mark in commerce.

WHEREFORE, Petitioner respectfully requests that Registrant's registration be cancelled and removed from the Supplemental Register.

This Petition to Cancel is submitted in duplicate. If there are any additional fees due, the Commissioner is hereby authorized to charge them to our Deposit Account No. 50-1833.

DATED: August 4, 2005

Respectfully submitted,

Brasserie De Tahiti
Petitioner

By: 

Benita M. Das

GREENBERG GLUSKER FIELDS
CLAMAN MACHTINGER
& KINSELLA LLP
1900 Avenue of the Stars, Suite 2100
Los Angeles, California 90067-4590
Tel.: (310) 201-7438
Fax: (310) 201-2338
bdas@ggfirm.com

Attorneys for Petitioner

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-07-14 14:27:22 ET

Serial Number: 76604251

Registration Number: (NOT AVAILABLE)

Mark

O'TAHITI

(words only): O'TAHITI

Standard Character claim: Yes

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2005-03-15

Filing Date: 2004-07-26

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 112

Attorney Assigned:
SAPPENFIELD ANN ELIZABETH Employee Location

Current Location: M30 -TMO Law Office 112

Date In Location: 2005-03-15

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Brasserie De Tahiti S.A.

Address:
Brasserie De Tahiti S.A.
17 Place Notre Dame, BP 597
Papeete, Tahiti 98713
French Polynesia

Legal Entity Type: Corporation
State or Country of Incorporation: French Polynesia
Phone Number: 46 76 00
Fax Number: 46 76 39

GOODS AND/OR SERVICES

International Class: 032
Bottled water
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-03-15 - Non-final action mailed
2005-03-15 - Non-Final Action Written
2005-02-28 - Case file assigned to examining attorney
2004-08-09 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Kevin DeBré (Attorney of record)

KEVIN DEBRÉ
GREENBERG GLUSKER FIELDS CLAMAN
1900 AVENUE OF THE STARS, SUITE 2100
LOS ANGELES, CALIFORNIA 90067-4590

Phone Number: (310) 201-7453
Fax Number: (310) 553-0687

Domestic Representative

Kevin DeBré

Phone Number: (310) 201-7453

Fax Number: (310) 553-0687

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-07-14 14:26:50 ET

Serial Number: 76313393

Registration Number: 2637736

Mark (words only): TAHITI

Standard Character claim: No

Current Status: Registered.

Date of Status: 2002-10-15

Filing Date: 2001-09-18

Transformed into a National Application: No

Registration Date: 2002-10-15

Register: Supplemental

Law Office Assigned: LAW OFFICE 111

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-07-28

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Marshall, Daniel

Address:

Marshall, Daniel
270 N. Canon Drive #1239
Beverly Hills, CA 90210
United States

Legal Entity Type: Individual

Country of Citizenship: United States

Phone Number: 714 844-9275

Fax Number: 714 844-9275

GOODS AND/OR SERVICES

International Class: 032

bottled drinking water

First Use Date: 2002-02-18

First Use in Commerce Date: 2002-03-13

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-10-15 - Registered - Supplemental Register

2002-06-26 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2002-06-26 - Amendment to Use approved

2002-06-18 - Amendment to use processing complete

2002-06-04 - Amendment to Use filed

2002-06-04 - Communication received from applicant

2001-12-13 - Non-final action mailed

2001-11-29 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

Daniel Marshall (Attorney of record)

DANIEL MARSHALL

270 N CANON DR # 1239

BEVERLY HILLS CA 90210-5323

Phone Number: 714 844-9275

Fax Number: 714 844-9275

MINISTRY
OF THE ECONOMY AND FINANCE

The Minister

Matter handled by
Line Line Failloux

FRENCH POLYNESIA

N° 1925/MEF

Papeete, October 18, 2004

To

Mr. Hubert VIARIS de LESEGNO
General Manager of Brasserie de Tahiti
BP 597 Papeete

Re: Exporting "O'TAHITI" water – TAHITI Brand

Ref: Your letter N° HVL.cl.2004/L083

Dear Sir,

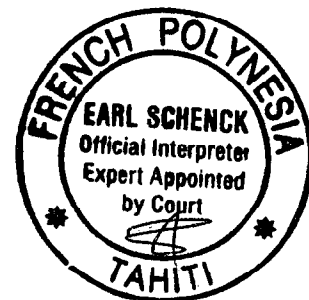
Firstly, I wish to congratulate you for the enthusiasm of your group. In fact, Brasserie de Tahiti reflects the skills of its personnel and innovative research with a view to adapting the company to progress in respect to quality requirements.

To follow-up to your letter referred to hereabove, and after having run a check with the Customs Department on the data for water exports to the U.S.A. since the year 2000, I confirm to you that Mr. Daniel Marshall is not on the list of importers of water to the U.S.A. In other words, Mr. Daniel Marshall presents no activity of water exports of Polynesian origin to the United States of America.

I hope to have responded to your expectations and remain,

Sincerely,

Signature of Emile Vanfasse
Stamp



Certified true to the original
Written in French
NE VARIETUR. Delivered under
N° 806 on October 28, 2004
To serve all legal intents and purposes

French Polynesia

FRENCH REPUBLIC

Freedom – Equality - Brotherhood

**MINISTRY OF ECONOMY
& FINANCE**

*in charge of Industry & Small- and Medium-sized
Business, budget & Taxation*

**CUSTOMS DEPARTMENT
OF FRENCH POLYNESIA**

P.O. Box No. 9006 – 98715 CTC
Papeete – Tahiti, French Polynesia^
Tel: (689) 50 55 50
Fax: (689) 43 55 45

No. 001022/MEF/D

Papeete – April 26, 2005

File handled by: Roseline Deslondes
e-mail: <http://www.roseline.deslondes@douane.pf>

The Regional Manager

to

The Minister of Economy & Finance, in charge of
Industry, Small- and Medium-Sized Businesses,
Budget & Taxation

Subject: Export of water to the United States
Reference: E-mail from Mr. Céran-Jerusalem dated April 21, 2005.

Dear Sir,

Further to your above-referenced request, please find herein-below the information as follows:

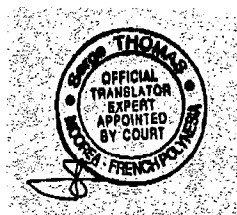
The companies "exporting" mineral water to the United States are the following:

AIR TAHITI NUI
SERVICES ET TRANSPORTS TAHITI
BRASSERIE DE TAHITI

Regarding the first two companies, this is not strictly speaking export to the United States but only consumption of mineral water on board means of transportation.

Therefore, Daniel Marshall still does not carry out export of mineral water to the United States,

Signed: Joel Quiniou
Regional Manager
Customs Department



Certified a true and
faithful legal translation
delivered in Moorea
on May 03, 2005